



PATENT  
Customer No. 22,852  
Attorney Docket No. 04853.0059

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Kazunari TAIRA et al. ) Group Art Unit: 1635  
)  
Application No.: 09/763,590 ) Examiner: M. Schmidt  
)  
Filed: February 26, 2001 )  
)  
For: EXPRESSION SYSTEMS FOR )  
TRANSCRIPTION OF )  
FUNCTIONAL NUCLEIC ACIDS )

#9/1.7.  
11/21  
ELECTION

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Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This paper is responsive to the Office Action mailed September 13, 2002, which set a shortened statutory period for response of one month. In a separate petition, Applicants have requested and paid the fee for a one-month extension of time. Thus, this response is timely filed.

The Office has issued a restriction requirement, asserting that pending claims 1-15 are directed to three allegedly separate and distinct inventions as follows:

Group I: claims 1-7 and 10, drawn to compositions and methods comprising bases 1-80 or the entire SEQ ID NO:1;

Group II: claims 2-7 and 11, drawn to compositions and methods comprising bases 1-86 or the entire SEQ ID NO:2;

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street NW  
Washington, DC 20005  
202 408 4000  
Fax 202 408 4400  
www.finnegan.com

11/15/2002 EMAIL: 00000002 060916 09763590

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Group III: claims 8, 9, and 12-15, drawn to compositions and methods comprising SEQ ID NO:4.

Applicants are required to elect a group for examination on the merits. Office Action, page 3. To be fully responsive to the restriction requirement, Applicants elect group 1 (claims 1-7 and 10, drawn to compositions and methods comprising bases 1-80 or the entire SEQ ID NO:1), with traverse.

As grounds for the restriction requirement, the Office asserts that the different sequences recited in the claims (SEQ ID NOS: 1, 2, and 4) represent different products that do not share a common core structure and activity. Thus, the inventions allegedly lack unity of invention. Applicants respectfully disagree. For example, SEQ ID NOS: 1 and 2 are highly homologous (*i.e.*, share a common core sequence). In fact, Applicants have informed the undersigned that SEQ ID NO:1 differs from SEQ ID NO:2 by only 6 nucleotides (at positions 83-88). Thus, these two sequences share a common core structure. Moreover, SEQ ID NOS: 1 and 2 are disclosed as having a common function or activity as ribozymes. Thus, at the very least, Groups I and II do not lack unity of invention and should be rejoined for purposes of examination.

Additionally, Applicants note that no serious burden is imposed on the Office in conducting a search of groups I, II, and III together. A complete search of the nucleic acids of group I will produce art that is relevant to each of the groups. Applicants note that significant portions of SEQ ID NOS: 1 and 2 are included within the scope of claim 8 (group III). Accordingly, Applicants respectfully request that groups I, II, and III be rejoined for examination on the merits.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 L Street, NW  
Washington, DC 20005  
202 408 4000  
Fax 202 408 4400  
www.finnegan.com

If necessary, please grant any extensions of time required to enter this response  
and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 13, 2002

By: 

M. Todd Rands  
Reg. No. 46,249

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street NW  
Washington, DC 20005  
202 408 4000  
Fax 202 408 4400  
www.finnegan.com